

REMARKS

This is in response to the Office Action of March 21, 2008. Claims 1-51 are pending in the present application, of which claims 33-45 and 47-51 stand withdrawn from consideration. Applicants' claim set is amended to obviate objections and rejections under the second paragraph of 35 U.S.C. § 112. No new matter is introduced.

Information Disclosure Statement

At the bottom of page 2 of the Office Action, the Examiner refers to an IDS¹ which cited a U.S. patent and a NPL document. Accompanying the Office Action is a copy of the SB/08 in question, in which both references are crossed out. Applicants note that the U.S. patent in question is cited in another IDS filed in the present application, and so is properly crossed out as duplicative. With regard to the NPL document (an article by C.F.P. George), the Examiner requests a copy thereof. Applicants provide herewith a copy of the article in question. The Examiner is respectfully requested to indicate consideration of that article (which article is discussed on page 3 of Applicants' specification) by initialing the enclosed copy of the originally filed SB/08.

Specification

At the top of page 3 of the Office Action, the Examiner objects to allegedly incorrect nomenclature used throughout the specification. The present substitute specification changes "prop-2-anyl" to "2-propynyl" throughout the specification. No new matter is introduced by way of the enclosed substitute specification.

Objections and rejections under the second paragraph of 35 U.S.C. § 12.

On page 3 of the Office Action, the Examiner objects to claims 22 and 24-32. On page 4 of the Office Action, the Examiner rejects claims 1, 2, 5, 8-22, 24, 26-29, 31, 32, and 46 under the second paragraph of 35 U.S.C. § 112. Each of these formal objections and rejections is obviated by the present amendments of the claims.

¹ Information Disclosure Statement filed December 28, 2005.

Enablement

On pages 5-9 of the Office Action, generic claims 1-21 and 46 were rejected under the first paragraph of 35 U.S.C. § 112 as allegedly exceeding the scope of the enabling disclosure. The definitions of the variables R₁, R₂, and R₃ in independent claim 1 have been limited to scopes acknowledged by the Examiner to be enabled, thereby obviating this ground of rejection.

Rejection over Dusza - US

Claims 1, 5, 6, 8-21, 24, 26-32, and 46 are rejected under 35 USC 103(a) as being obvious over US 4,654,347 (US '347). Office Action, page 10. The rejection is respectfully traversed.

US '347 discloses in its Example 80 a compound excluded from the claims by Applicants' "proviso that simultaneously: R₁ may not be p-tolyl and R₂ methyl and R₃ benzoyl." In US '347, the reference compound is disclosed only as being an intermediate in the synthetic production of final products. The Examiner contends that another embodiment in Applicants' claims – in which R₁ is p-tolyl and R₂ is methyl and R₃ is carbonyl-thienyl – is *prima facie* obvious over the reference compound.

Applicants respectfully traverse this rejection on the ground that close structural similarity alone is not sufficient to create a *prima facie* case of obviousness when the reference compounds lack utility, and thus there is no motivation or rationale to make related compounds. *In re Steminski*, 170 USPQ 343 at 348. Where – as here – the prior art merely discloses compounds as intermediates in the production of a final product, a person of ordinary skill in the art would not be motivated or provided with the proper rationale to stop the reference synthesis and investigate the intermediate compounds with an expectation of arriving at claimed compounds which have different uses. *In re Lalu*, 223 USPQ 1257. Accordingly, the rejection of record over US '347 should be withdrawn.

Rejection over Dusza - EP

Claims 1, 5, 6, 8-21, 24, 26-32, and 46 are rejected under 35 USC 103(a) as being obvious over EP 0 129 847. Office Action, page 11. EP '847 discloses in its Example 166 a

compound excluded from the claims by Applicants' "proviso that simultaneously: ... R₁ may not be p-tolyl and R₂ ethyl and R₃ furyl-2-carbonyl." In EP '847, the reference compound is disclosed only as being an intermediate in the synthetic production of final products. The Examiner contends that another embodiment in Applicants' claims – in which R₁ is p-tolyl and R₂ is methyl and R₃ is carbonyl-pyridyl – is *prima facie* obvious over the reference compound.

Applicants respectfully traverse this rejection on the ground that close structural similarity alone is not sufficient to create a *prima facie* case of obviousness when the reference compounds lack utility, and thus there is no motivation or rationale to make related compounds. *In re Stemniski*, 170 USPQ 343 at 348. Where – as here – the prior art merely discloses compounds as intermediates in the production of a final product, a person of ordinary skill in the art would not be motivated or provided with the proper rationale to stop the reference synthesis and investigate the intermediate compounds with an expectation of arriving at claimed compounds which have different uses. *In re Lalu*, 223 USPQ 1257. Accordingly, the rejection of record over EP '847 should be withdrawn.

Contact information

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher, Registration No. 28,781, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: June 23, 2008

Respectfully submitted,

By *Gene S. Weiner* #448,501
Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant